claimed invention to one of three groups of distinct inventions.

The Examiner asserted that the application contains patentably distinct inventions as follows:

Group I, directed to claims 1-39 and drawn to a storage device, classified in class 198, subclass 778;

Group II, directed to claims 40-45 and drawn to a storage device, classified in class 198, subclass 778; and

Group III, directed to claims 46-51 and drawn to a storage device, classified in class 198, subclass 778.

In support of this restriction requirement, the Examiner asserted that the inventions were related as combination and subcombination, and that the inventions are distinct from each other under M.P.E.P. § 806.05(c) because the "combination as claimed does not require the particulars of the subcombination as claimed because the storage device does not require the at least one stationary disc tower with a spindle and a movable disc tower with a spindle." The Examiner also explained that "[t]he subcombination has separate utility such as storing a plurality of storage discs on the spindles."

Applicant initially notes that, contrary to the Examiner's assertions, each of the groups recite at least one stationary disc tower with a spindle and a movable disc tower with a spindle (see claims 11, 40 and 46). Therefore, Applicant submits that, contrary to the Examiner's assertions, the combination clearly recites the particulars of the subcombination.

Furthermore, it is apparent that the Examiner has not fully considered the language

of the claims and the requirement for setting forth a proper basis for restriction under M.P.E.P. § 806.05(c). That section clearly indicates that "[i]n order to establish that combination and subcombination inventions are distinct, two-way distinctiveness must be demonstrated" (emphasis added). Thus, it must be shown first that one group recites a feature that is not recited in the other group, and second that the other group recites a feature that is not in the one group. This has clearly not been demonstrated by the Examiner. Nor can it be when all of the groups recite numerous common or similar features.

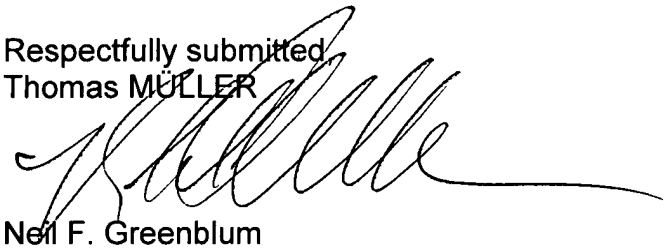
Applicant also respectfully submits that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged (incorrectly) possible distinctions between the three identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, the Examiner has noted that the individual groups would be classified in the same class and subclass, i.e., class 198, and subclass 778. Nor has the Examiner properly and convincingly set forth an appropriate statement indicating that the search areas required to examine the invention of group I (directed to claims 1-39) would not overlap into the search areas for examining the invention of group II (directed to claims 40-46) and group III (directed to claims 46-51), and vice versa. Applicant respectfully submits that the search for the

combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I -III. For all of the above reasons, the Examiner's restriction requirement is believed to be improper.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Thomas MÜLLER



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